

Remarks

This Application has been carefully reviewed in light of the final Office Action mailed April 5, 2004. Applicant appreciates the Examiner's consideration of the Application. Although Applicant believes all previously pending claims are allowable, to expedite issuance of the Applicant, Applicant has cancelled independent Claims 1, 4, and 23; rewritten Claims 7, 15, and 26 in independent form; amended Claim 34; amended Claims 2-3, 8, and 14 to depend from Claim 7; amended Claims 5-6, 16, and 22 to depend from Claim 15; and amended Claims 24-25, 27, and 33 to depend from Claim 26. At least the amendments to Claims 7, 15, and 26 are not considered narrowing, and none of these amendments are considered necessary for patentability. Applicant respectfully requests reconsideration and allowance of all pending claims.

The Rejections under 35 U.S.C. § 102(e) are Moot

The Examiner rejects Claims 1-6, 8, 11-12, 14, 16, 19-20, 22-25, 27, 30-31, and 33-34 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,233,493 to Cherneff, et al., ("*Cherneff*").

Although Applicant believes independent Claims 1, 4, 23, and 34, and their respective dependent claims, are allowable over *Cherneff*, the rejections of Claims 1, 4, 23, and 34 under Section 102(e) are moot in view of the amendments presented in this Response. In particular, Applicant has cancelled independent Claims 1, 4, and 23, and rewritten dependent Claims 7, 15, and 26 in independent form, including substantially similar limitations to those recited in now-cancelled independent Claims 1, 4, and 23, respectively. Additionally, independent Claim 34 has been amended to recite substantially similar limitations to those recited in dependent Claims 7, 15, and 26. As the Examiner did not reject dependent Claims 7, 15, and 26 as being anticipated by *Cherneff*, the rejections under 35 U.S.C. § 102(e) are moot as to amended Claims 7, 15, 26, and 34, and their respective dependent claims. By not specifically responding to the Examiner's conclusions regarding the application of *Cherneff* to Applicant's claims, Applicant does not necessarily acquiesce to or agree with the Examiner's conclusions.

Cherneff is Disqualified as Prior Art as to the Rejections under 35 U.S.C. § 103

The Examiner rejects Claims 7, 9-10, 15, 17-18, 26, and 28-29 under 35 U.S.C. § 103(a) as being unpatentable over *Cherneff* in view of U.S. Patent 6,578,005 to Lesaint, et al. ("*Lesaint*"). The Examiner also rejects Claims 13, 21, and 32 under 35 U.S.C. § 103(a) as being unpatentable over *Cherneff* in view of *Lesaint* and further in view of U.S. Patent 5,408,663 to Miller ("*Miller*").

As discussed above, Applicant has rewritten dependent Claim 7 in independent form (including substantially similar limitations to those recited in now-cancelled independent Claim 1), rewritten dependent Claim 15 in independent form (including substantially similar limitations to those recited in now-cancelled independent Claim 4), and rewritten dependent Claim 26 in independent form (including substantially similar limitations to those recited in now-cancelled independent Claim 23). Applicant has also amended dependent Claims 2-3, 8, and 14 to depend from now-independent Claim 7; rewritten dependent Claims 5-6, 16, and 22 to depend from now-independent Claim 15; rewritten dependent Claims 24-25, 27, and 33 to depend from now-independent Claim 26; and amended independent Claim 34 to recite substantially similar limitations to those recited in previously-dependent Claims 7, 15, and 26. While Applicant does not necessarily acquiesce to or agree with the Examiner's conclusions regarding the application of *Cherneff* to Applicant's claims, pursuant to 35 U.S.C. § 103(c), Applicant respectfully submits that *Cherneff* is disqualified as a reference against the claimed invention.

According to 35 U.S.C. § 103(c), subject matter that qualifies as prior art only under 35 U.S.C. § 102(e) "shall not preclude patentability under [35 U.S.C. § 103] where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." In other words, subject matter that is considered prior art only under 35 U.S.C. 102(e) is disqualified from use as a prior art reference under 35 U.S.C. 103 if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." M.P.E.P. §§ 706.02(k) and 706.02(l)(1).

To the extent that *Cherneff* may qualify as prior art under Section 102(e), Section 103(c) disqualifies *Cherneff* as a prior art reference against the claimed invention because the inventors of *Cherneff* and of the present invention were under a common obligation of assignment at the time the present invention was made to i2 Technologies, Inc., and that *Cherneff* was actually assigned to i2 Technologies, Inc. at that time. Support for this common ownership can be found in the Assignment Records of the U.S. Patent and Trademark Office. An assignment of *Cherneff* from the inventors in *Cherneff* to i2 Technologies, Inc. was recorded on September 16, 1998 at Reel, 9468, Frames 0473-0476. The inventor of the present invention was, at the time the present invention was made, under an obligation of assignment to i2 Technologies, Inc. pursuant to an employment agreement. Furthermore, both *Cherneff* and the present invention were ultimately assigned to i2 Technologies US, Inc. An assignment of *Cherneff* from i2 Technologies, Inc. to i2 Technologies US, Inc. was recorded on July 30, 2001 at Reel 012025, Frames 0811-0822. An assignment of the present Application from the inventor to i2 Technologies US, Inc. was recorded on November 13, 2001 at Reel 012300, Frames 0249-0251. Moreover, this application was filed October 8, 2000, which is prior to the date when *Cherneff* issued as a patent (May 15, 2001). *Cherneff*, therefore, was not published or patented until after Applicant's invention date for the invention claimed herein.

As a result, Applicant respectfully submits that *Cherneff* is disqualified as a prior art reference against the claimed invention because both *Cherneff* and the present Application were subject to a common obligation of assignment at the time of the present invention and the filing date of this Application preceded the date *Cherneff* issued as a patent. At least because the primary reference (*Cherneff*) in the Examiner's proposed combinations of references for the rejections under Section 103 is unavailable as a reference, Applicant respectfully submits that the combinations of references proposed by the Examiner cannot be made. For at least this reason, Applicant respectfully requests withdrawal of the rejections based on *Cherneff*.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of all pending claims.

Applicant requests that this Response under 37 C.F.R. § 1.116 be entered by the Examiner. The proposed amendments do not raise new issues or necessitate a new search by the Examiner; therefore, this Response should allow for immediate action by the Examiner.

Furthermore, Applicant points out that the final Office Action presented new arguments as to the Application of the references against the claimed invention. It is respectfully submitted that entry of the amendments presented in this Response would allow Applicant to reply to the final Office Action and place the Application in condition for allowance.

Finally Applicant submits that entry of the amendments would place the Application in better condition for Appeal, should the Examiner dispute the patentability of the pending claims. The claimed invention is neither anticipated nor rendered obvious in view of the references cited against this Application. Applicant therefore requests entry of these amendments, the Examiner's reconsideration and of the Application, and the timely allowance of all pending claims.

Conclusion


Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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